APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,878	05/25/2001	Susan Phillips	40655.1700	5094

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EXAMINER
COBY, FRANTZ

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>01 December 2004</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-41</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-41</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

This is in response to Applicant's amendment filed on December 01, 2004 in which

claims 34 and 36 were amended and claims 42-43 were indicated canceled.

Status of Claims

Claims 1-41 are pending.

Applicant's arguments filed on December 01, 2004 have been fully considered

but they are not persuasive. Therefore the rejection of claims 1-41 mailed on September

08, 2004 under section 103(a) remains.

The rejection follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Block U.S. Patent no. 5,960,416 in view of Geerlings U.S. Patent no. 5,956,693.

As per claim 1, Block discloses "a computer implemented service for updating a

merchant customer account database over a network" by providing a real time

subscriber billing system that calculates charges for a desired service at a subscriber

location in a communication network (See Block Col. 3, lines 9-12). In particular, Block

discloses the claimed feature of "first comparison data file comprising a first record

including a compilation of said merchant processing requests accepted for processing

by said process server, said first comparison data file further comprising a second

record including a compilation of said merchant processing requests rejected for

processing by said process said process server" (See Block Abstract). Further, Block

discloses the claimed features of "process server configured to update said first

database Of information in accordance With Said merchant processing request data

file" (See Block Col. 3, lines 40-46).

It is noted, however, Block did not specifically detail the claimed limitations of "a

first database of information having a plurality of merchant customer records and a

remote merchant customer database having a first plurality of customer account's as a

first and second database" as recited in the instant claim. On the other hand, Geerlings

discloses the aforementioned claimed features by providing a computer system for

merchant communication to customers including a first database that stores

identification and demographics of customers and a second database that stores

communication information and indications of contents of communications (See

Geerlings Col. 2, lines 12-20). Also, Block did not specifically detail the aspect of "a

merchant process server for appending a merchant processing request to at least

records', one of said first plurality of customer accounts to produce a merchant

processing request data file; and a process server for receiving said first database of

information and said merchant processing request data file, said process server

configured to compare said first database of information and said merchant processing

request data file to produce a first comparison data file" as recited in the instant claim.

On the other hand, Geerlings discloses the aforementioned claimed features by

providing a computer system for merchant communication to customers including

processors for appending data as well as producing data file (See Geerlings Col. 2,

lines 21-50).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the billing system of block wherein the network device provided

thereof (See Block Figure 1, component 30) would have incorporated the databases of

Geerlings and a mechanism for producing a data file. The motivation being to have

enhanced the billing system of Block by allowing it to efficiently permit merchants and

customers to communicate and enable merchants communication of a desired message

to an appropriate recipient group at a desired time to be automated through computer
means (See Geerlings Abstract).

As per claim 2, most of the limitations of this claim have been noted in the
rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In
addition, Geerlings discloses the claimed limitations of "wherein, said service further
comprises a second database of information having a second plurality of customer
transaction accounts records" as a marketing database 19 of figure 1 where customers
information is stored (See Geerlings Col. 4, lines 22-30).

As per claim 3, most of the limitations of this claim have been noted in the
rejection of claim 2. Applicant's attention is directed to the rejection of claim 2 above. In
addition, Geerlings discloses the claimed limitations of "wherein, said process server is
configured to receive said second database of information, said process server
configured to compare said first database of information and said second database of
information to produce a second comparison data file, said second comparison file
comprising a plurality of updated customer transaction account records, said process
server further configured to update said first database of information in accordance with
said second database of information" (See Geerlings Col. 4, lines 31-44).

As per claim 4, most of the limitations of this claim have been noted in the
rejection of claim 4. Applicant's attention is directed to the rejection of claim 4 above.

In addition, Geerlings discloses the claimed limitations of "wherein, said process server is further configured to append a provider processing instruction to at least one of said plurality of updated customer transaction account records to produce a provider processing request data file" (See Geerlings Col. 4, lines 37-44).

As per claim 5, most of the limitations of this claim have been noted in the rejection of claim 4. Applicant's attention is directed to the rejection of claim 4 above. In addition, Geerlings discloses the claimed limitations of "wherein said process server is configured to provide an update summary file, said update summary comprising at least one of said first comparison data file and said provider processing request data file" as a definition database that holds file formats and layouts of the transmitted downloaded data (See Geerlings Col. 4, lines 40-44).

As per claims 6-13, most of the limitations of these claims have been noted in the rejection of claims 1-5. Applicant's attention is directed to the rejection of claims 1-5 above. In addition, Geerlings discloses the claimed limitations of "wherein said update summary report is provided to said merchant process server periodically" since merchant constantly updates the shopping activity information (See Geerlings Col. 4, lines 32-33, Col 6, lines 13-16) wherein, said merchant process server is configured to retrieve said update summary file" since online accessibility of the information stored in the databases is provided (See Geerlings Col. 4, lines 54-57) and a structured query language is provided (See Geerlings Col. 5, lines 58-61); wherein, said merchant server

is further configured to update said remote merchant customer database in accordance

with said update summary file" since an update mechanism is provided

(See Geerlings (Col. 4, lines 31-44), "wherein, said at least one of said first plurality of

customer transaction account records is pre-authorized; wherein, said at least one of

said first plurality of distinct customer transaction account records is provided a

merchant processing request indicating that said at least one of said first plurality of

customer transaction account records is to be removed from at least one of said

plurality of merchant customer record; wherein said at least one of said first plurality of

customer transaction account records is provided a merchant processing request

indicating that said at least one of said first plurality of distinct customer transaction card

records requires alteration by said process server', wherein said remote merchant

customer database is configured to be updated manually', wherein said merchant server

is configured to update said remote merchant customer database in accordance with

said provider processing instruction" all update request are achieved through the update

mechanism as shown in (Geerlings Col. 4, lines 31-44).

As per claims 14-22, most of the limitations of these claims have been noted in

the rejection of claims 1-13. Applicant's attention is directed to the rejection of claims 1-

13 above. In addition, Block discloses the claimed limitations of wherein said rejected

merchant process request is verified" since a determination is made based on the

account information whether the subscriber has a sufficient balance for a desired

service. Service is authorized or denied based on the determination (See Block

Abstract). The Applicant should duly note that it is the merchant that process the request made by the subscriber. Therefore, a denied of the subscriber, yield a denied of the merchant's process request. As to the claimed features of wherein said merchant process server appends said verified rejected merchant process request to said merchant process request data file, " wherein said merchant process request data file includes said verified rejected merchant process request"; "wherein said process server is configured to tally the number of rejected merchant processing request wherein said process server comprises a predetermined rejection threshold; wherein said process server compares the rejection threshold to said tally of the number of rejected merchant process request, said process server further configured reject said merchant process request data file when the rejection threshold is reached"; wherein said process server is configured to tally said accepted merchant processing request, in accordance with a merchant process request grouping; "wherein said update summary file comprises said tally said accepted merchant processing request" and " wherein at least one of said first plurality of customer transaction accounts is outdated, said process server being configured to add said outdated at least one of said first plurality of customer transaction account records to said first database of information, said outdated one of said first plurality of customer transaction account records remaining permanently fixed", these are features of the verification strategy of Block's billing system They are therefore primarily incorporated in the billing system of Block.

As per claims 23-41, all the limitations of these claims have been noted in the rejection of claims 1-22. They are therefore rejected as set forth above. In addition, the combination of Block-Geerlings can implement a merchant database to have a number of customer transaction account records, including providing a transaction account record in a registry file, using the plurality of databases of Geerlings (See Geerlings Figure 1 and corresponding text).

Remarks

Applicant argued that "the step of comparing as disclose by Block does not compare two sets of data to find similarities, but instead, it determines transaction level detail regarding a subscriber account and available services" and that "the comparison step does not result in the updating of one or both of the data sources with the same information". However, the Examiner disagrees with the preceding argument because the system of Block is directed to real-time subscriber billing at a subscriber location in an unstructured communication network in which account information is stored at the service provider location and used to monitor the service record of the subscriber and update the service provided to the subscriber accordingly. This is a clear indication that Block discloses a comparison step that results in the updating of one or both of the data sources with the same information. In this particular case, the service provided to the subscriber is updated (See Block Abstract; Col. 3, lines 9-46).

The Applicant also argued, that "the updating of Block does not result in a synchronization in order to ensure both data sets contain the same data". The Examiner, on the other hand, disagrees with the preceding argument because the claimed feature that the Applicant is referring to is not present in the claims, especially in the independent claims. Further, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the updating of Block does not result in a synchronization in order to ensure both data sets contain the same data) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Last, the Applicant argued that "The appending, or attaching step as disclosed in Geerlings is intended to add an attachment to a communication in a manner which is very similar to attaching a file to an email document" and that "Geerlings does not disclose appending a transaction identifier to a record in order to instruct a process server how to process a customer record. The Examiner respectfully submits that On the other hand, Geerlings discloses the aforementioned claimed features by providing a computer system for merchant communication to customers including processors for appending data as well as producing data file (See Geerlings Col. 2, lines 21-50) and that the feature of "appending "a transaction identifier" to a record in order to instruct a process server how to process a customer record is not present in the claims, especially

the independent claims. Therefore, this argument is mute. Further, In response to

applicant's argument that the references fail to show certain features of applicant's

invention, it is noted that the features upon which applicant relies (i.e., appending "a

transaction identifier" to a record in order to instruct a process server how to process a

customer record) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Frantz Coby whose telephone number is 571 272 4017.

The examiner can normally be reached on Monday-Saturday 3:00PM-10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic can be reached on 571 272 4023. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).
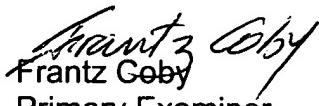
Frantz Coby
Primary Examiner
Art Unit 2161

March 19, 2005